

Remarks

Favorable reconsideration is respectfully requested in light of the following comments. No claim amendments have been presented herein.

Applicants respectfully traverse the Examiner's rejection of claims 37-39, 44-49 and 50-55 under 35 U.S.C. §102(b) as anticipated by Barbut et al. (U.S. Patent No. 5,997,557). Apparently, the Examiner intended to reject these claims under 35 U.S.C. §102(e), as Barbut et al. are not available as prior art under 35 U.S.C. §102(b). The Examiner is reminded that the instant application has an effective U.S. filing date, by virtue of its continuing status, of August 4, 1999. This predates the issuance of Barbut et al. Therefore, Applicants will address the rejection as though properly made under 35 U.S.C. §102(c).

In order to anticipate, the cited reference must disclose each and every claimed element. Barbut et al. appears to fail to so do. In particular, it is noted that each of the independent claims require that an expandable filter be attached to an elongate member, and that the expandable filter has a distal end that extends distally from a distal end of the elongate member. Further, as amended, a proximal edge of the filter is attached to the elongate member proximally of the distal end of the elongate member. A therapeutic catheter is required to be at least partially disposed within a lumen defined by the elongate member.

The Examiner has pointed to element (69) of Barbut et al. as meeting the claimed expandable filter, apparently glossing over the claimed requirement that the filter extend distally from a distal end of an elongate member to which the filter is attached. Filter (69) does not meet this claimed limitation, and thus the reference cannot be considered as anticipatory.

It is noted that Figure 9A of Barbut et al. may be construed as showing a filter extending distally from a distal end of an elongate member to which it is attached, but it appears that the reference does not disclose that a proximal edge of the filter is attached to the elongate member proximally its distal end where the distal edge of the filter is disposed distally of the distal end. Again, Barbut et al. cannot be considered as anticipating the claimed invention. Apparently, dependent claims 38-39, 48-49 and 50-55 are respectively asserted not to be anticipated by Barbut et al., and further because

these claims recite additional significant elements. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 40-43 under 35 U.S.C. §103(a) as unpatentable over Barbut et al. (U.S. Patent No. 5,997,557) in view of Winston et al. (U.S. Patent No. 6,228,076). Claim 37, from which claims 40-43 depend, has been distinguished as patentable over Barbut et al. Winston et al. do not remedy the noted shortcomings of Barbut et al., and thus claim 37 (and claims 40-43 depending therefrom) is patentable over the cited combination. These dependent claims also recite other significant elements. Favorable reconsideration is respectfully requested.

Applicants respectfully traverse the Examiner's rejection of claims 37-55 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-20 of U.S. Patent No. 6,235,044. While Applicants do not concede the correctness of the rejection, it is noted that the instant application has an effective filing date set by the cited reference. Thus, absent potential term extension, the term of the instant application has already been set by the cited parent. Accordingly, and in order to facilitate prosecution, an appropriate Terminal Disclaimer is hereby provided.

Applicants respectfully traverse the Examiner's rejection of claims 47-55 under the judicially created doctrine of obviousness-type double patenting as unpatentable over claims 1-19 of U.S. Patent No. 6,673,090. While Applicants do not concede the correctness of the rejection, it is noted that the instant application shares an effective filing date with the cited reference. Thus, absent potential term extension, the term of the instant application has already been set by the cited parent. Accordingly, and in order to facilitate prosecution, an appropriate Terminal Disclaimer is hereby provided.

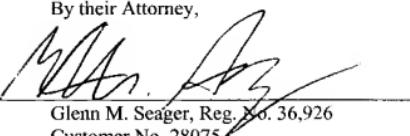
Reexamination and reconsideration are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

JONATHAN D. ROOT ET AL.

By their Attorney,

Date: Feb 19, 2006



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